



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/890,926	08/07/2001	Shinji Tanaka	1265-01	1861
35811	7590	09/28/2005	EXAMINER	
IP GROUP OF DLA PIPER RUDNICK GRAY CARY US LLP 1650 MARKET ST SUITE 4900 PHILADELPHIA, PA 19103			GILLIAM, BARBARA LEE	
		ART UNIT		PAPER NUMBER
				1752

DATE MAILED: 09/28/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/890,926	TANAKA ET AL.	
	Examiner	Art Unit	
	Barbara L. Gilliam	1752	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 13 July 2005.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 2-5 and 12 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) 2-5 is/are allowed.
- 6) Claim(s) 12 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some * c) None of:
1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on July 13, 2005 has been entered.

2. -Claims 2-5 and 12 are pending.

Applicant canceled claims 6, 10 and 11.

New Claim 12 was added. New claim 12, containing the subject matter of previous claim 6, meets the enablement requirements under 35 USC 112, 1st paragraph.

3. The objection to claims 3 and 5 are withdrawn in light of the amendment to claim 3.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claim 12 is rejected under 35 U.S.C. 102(b) as being anticipated by Barzynski et al. (US 4,555,471).

a. The image recording materials of Barzynski et al. meet the present limitations for the photosensitive resin printing plate material. Specifically, base, relief-forming layer (RL), intermediate layer (I) and mask-forming layer (ML) (see abstract; column 7, lines 40-65) meet the present limitations for the support, photosensitive resin layer, transfer-preventing layer and photocoloring layer respectively. Suitable materials for the relief-forming layer include polymeric binders such as polyvinyl alcohol and its derivatives and polyvinyl acetates, ethylenically unsaturated, photopolymerizable compounds and photoinitiators (column 6, line 24 – column 7, line 40). The intermediate layer has a thickness from 5 to 135 μm (.005 to 0.135 mm) (column 7, lines 64-65). Suitable resins for the intermediate layer include polyethylene (column 7, lines 41-53) which meets the present limitations for the hydrophobic resin. The mask-forming layer contains thermochromic system which when irradiated with an IR laser having a wavelength greater than 1.00 μm (1000 nm) undergoes an irreversible change in its absorption spectrum in the range from 300 to 420 nm. It can be such that before being irradiated with the IR laser, it has a low optical density with the optical density increasing as a result of irradiation or the reverse can be true (column 2, line 48 – column 4, line 5). The development is described in the Examples 2-4 and in column 8, lines 48-52.

Response to Arguments

6. Applicant's arguments filed July 13, 2005 have been fully considered but they are not persuasive.

a. With respect to new claim 12 which contains the subject matter of previous claim 6, Applicant argued Barzynski fails to disclose the claimed subject matter, specifically (1) the substance transfer-preventing layer is a hydrophobic resin or UV-curable resin when the photosensitive resin layer contains a water soluble resin and (2) the substance transfer-preventing layer is a water-soluble resin or UV-curable resin when the photosensitive resin layer is a hydrophobic resin. The Examiner disagrees. As pointed out in the rejection under 35 USC 102(b), the intermediate layer meets the present limitations for the transfer-preventing layer and the relief-forming layer meets the present limitations for the photosensitive resin layer. Suitable polymers for the intermediate layer include polyethylene, a hydrophobic resin (column 7, lines 41-53) and suitable polymers for the relief-forming layer include water-soluble polyvinyl alcohol and its derivatives (column 6, line 24 – column 7, line 40). Clearly, the intermediate and relief-forming layers of Barzynski satisfy the first condition (1) of claim 12. The Examiner's position is supported by Applicant specification at page 17, 1st paragraph.

Allowable Subject Matter

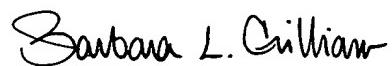
7. Claims 2-5 are allowed.
8. The following is a statement of reasons for the indication of allowable subject matter:

- a. Claims 2 and 4 were previously allowed.
- b. Claim 3 is allowed in light of the present amendment. Claim 5 is dependent on claim 3.

Conclusion

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Barbara L. Gilliam whose telephone number is 571-272-1330. The examiner can normally be reached on Monday through Thursday, 8:00 AM - 5:30 PM.

- a. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cynthia H. Kelly can be reached on 571-272-1526. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.
- b. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Barbara L. Gilliam
Primary Examiner
Art Unit 1752

Application/Control Number: 09/890,926
Art Unit: 1752

Page 6

Bg
September 25, 3005